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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,836	07/01/2003	Tommi Jokiniemi	2072-00065	5163
26753 7590 06/25/2008 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202				
EXAMINER				
BOR, HELENE CATHERINE				
ART UNIT		PAPER NUMBER		
3768				
MAIL DATE		DELIVERY MODE		
06/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/611,836

Applicant(s)

JOKINIEMI ET AL.

Examiner

HELENE BOR

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 1-6, 13-20, 27-34 & 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shahidi (20010025183 A1).

Claim 1-6, 13-20, 27-34 & 39-44: Shahidi teaches image acquisition (CT; Page 2, Para 0031& Page 3, Para 0042), registration image/patient, assigning target point on image, and adjusting the position and orientation of the instrument to the target point coordinate data (Page 4, Para 0050 & Figure 2). The robot is adjusted to determine the optimal point of entry to the target site within the patient's body (Page 4, Para 0043). Shahidi teaches a device that outputs the coordinates of the target, the orientation and the direction (Page 4, Para 0050). Shahidi do not mention distance specifically. The device of Shahidi tracks a target site and tracks the tip of the surgical tool as it approaches the target lesion (Page 4, Para 0051). It would have been obvious to one of ordinary skill in the art that the system of Shahidi take into account the relative distance of the target site to the biopsy needle as it approached the target (Page 4, Para 0050-0051) to move the actuator from a current position to the desired target (Page 2, Para 0017) in a coordinate system (Page 3, Para 0036).

3. Claim 7-12, 21-26, 35-38 & 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shahidi (20010025183 A1) as applied to claim 1-6, 13-20, 27-34 & 39-44 above, and further in view of Tofflemire (US Patent No. 2,840,070).

Claim 7-12, 21-26, 35-38 &45-47: Shahidi teaches the use of an instrument adapted to generate image signals indicative of the view along the axis of the instrument (Page 4, Para 0044) but Shahidi fails to teach the beam of light. However, Tofflemire teaches the use of light beams [light through an aperture] for providing a light-directing function to direct light where it is needed (Col. 1, Line 55-64) and to illuminate the field of operation (Col. 2, Line 63). It would have been obvious to one of ordinary skill in the art to modify the system of Shahidi to include the light beam as taught by Tofflemire in order to provide illumination to the field of operation (Col. 2, Line 63).

Response to Arguments

4. Applicant's arguments, see Page 21, filed 01/08/2008, with respect to 35 U.S.C. § 112, Second Paragraph rejection have been fully considered and are persuasive. The 35 U.S.C. § 112, Second Paragraph rejection of Claim 1 has been withdrawn.

5. Applicant's arguments, see Page 23, filed 01/08/2008, with respect to the rejection(s) of claim(s) 1-48 under 102(b) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Shahidi (20010025183 A1), and further in view of Tofflemire (US Patent No. 2,840,070).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELENE BOR whose telephone number is (571)272-2947. The examiner can normally be reached on M-T 8:30am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. B./
Examiner, Art Unit 3768

/Eric F Winakur/
Primary Examiner, Art Unit 3768